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In re Application of :  
Gerado M. Castillo et al :  
Serial No.: 09/748,748 : PETITION DECISION  
Filed: December 26, 2000 :  
Attorney Docket No.: 017170-0003-999 :

This is in response to the petition under 37 CFR 1.181, filed April 3, 2007, requesting withdrawal of the Final rejection.

#### BACKGROUND

A review of the recent file history shows that applicants filed RCE papers on February 3, 2006, accompanied by a required reply, including an amendment to the claims which limited the diseases/conditions being treated to Alzheimer's disease and type II diabetes. The examiner mailed a non-Final Office action to applicants on April 21, 2006. Included in the Office action was a single rejection under 35 U.S.C. 103(a) over Bok et al of claims 1-4 and 17-30. Claim 5, the only other remaining claim, was objected to as depending from a rejected claim (but otherwise allowable).

Applicants replied to the Office action on October 11, 2006, amending claim 1 by deleting diabetes as the treated disease in claim 1 and canceling claims 4 and 5. Applicants argued that the rejection of record was now moot.

The examiner then mailed a Final Office action to applicants on January 3, 2007, setting forth a new rejection under 35 U.S.C. 103(e) over JP02001008695 Abstract. The examiner made the action Final on the basis that the amendments necessitated the new rejection.

This petition was filed April 3, 2007, concurrently with a reply to the Office action.

#### DISCUSSION

Applicants argue that the Final Office action was improperly made Final since a new ground of rejection was made which should have been made in a previous Office action. A review of the actions of the examiner show that (a) claim 5, directed to Alzheimers disease was allowed (only objected to) in the non-Final Office action and claim 1, amended to recite only treatment of Alzheimers disease, was rejected over a new reference in the Final Office action. Rejection of

allowed subject matter over a new reference and making the action Final (a) is not permitted as per M.P.E.P. 706.07(a); (b) the rejection is over only the Abstract of the reference and no copy of the full reference is supplied, as required; and (c) the statutory basis is improper as only US Patent or Patent Publications or an International Application (PCT) published in English may be used under 35 U.S.C. 102(e). Only the Abstract, not the entire reference, was published in English. (Nor does the reference qualify under any other section of 35 U.S.C. 102.) In view of the above the finality of the Office action was improper and is withdrawn.

The petition is **GRANTED**.

**The Office action mailed January 1, 2007, is designated a non-Final Office action. The application will be forwarded to the examiner for consideration of applicant's reply filed concurrently with this petition on April 3, 2007, which will be treated as a reply to a non-Final Office action.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

Bruce M. Kisliuk  
Director, Technology Center 1600

